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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,787	07/17/2003	Christopher S. Piddington	99-08D1	5924

7590 09/29/2004

Brian J. Walsh  
ZymoGenetics, Inc.  
1201 Eastlake Avenue East  
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EXAMINER

MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/621,787

Applicant(s)

PIDDINGTON ET AL.

Examiner

Terry A. McKelvey

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 17-48 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

Art Unit: 1636

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 17-20, drawn to antibody, classified in class 530, subclass 387.1+.
- II. Claims 21-32 and 34-48, drawn to isolated polynucleotide (SEQ ID NO:1 or encoding SEQ ID NO:2), expression vector, cell, method of producing a polypeptide, classified in class 536, subclass 23.5 and class 435, subclasses 320.1, 325, 410, 243, and 69.1.
- III. Claim 33, drawn to isolated polynucleotide (SEQ ID NO:10), classified in class 536, subclass 23.5.

The inventions are distinct, each from the other because of the following reasons:

The antibody of Group I, the polynucleotide, etc of Group II, and the polynucleotide of Group III are chemically, biologically, and functionally distinct from each other and thus one does not render the other obvious. The products of one group are not required to produce the products of the other groups, which can be made synthetically or from cells, without

Art Unit: 1636

using the products of the other groups. Therefore, the inventions of these groups are capable of supporting separate patents.

Inventions of Groups I and III and Group II (the method part of the group) are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The products of Groups I and III are not used in or made by the method of Group II. The operation, function and effects of the products of Groups I and III are completely different and distinct from the operation, function and effects of the method of Groups II which produces a polypeptide. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search required for Group III is not required for Group II, with regards to the non-patent literature search because the polynucleotides of the two groups are different and thus require different searches, which searches have become too burdensome to do more than one due to the exponential expansion and corresponding increase of search time of the sequence databases, restriction for examination purposes as indicated is proper.

Art Unit: 1636

A telephone call was made to Brian Walsh on 8/30/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Conclusion***

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is 703-872-9306. NOTE: If Applicant does submit a paper by fax, the original signed copy should be

Art Unit: 1636

retained by applicant or applicant's representative. NO  
DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the  
processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status  
of this application or proceeding should be directed to (571)  
272-0547.

Patent applicants with problems or questions regarding  
electronic images that can be viewed in the Patent Application  
Information Retrieval system (PAIR) can now contact the USPTO's  
Patent Electronic Business Center (Patent EBC) for assistance.  
Representatives are available to answer your questions daily  
from 6 am to midnight (EST). The toll free number is (866) 217-  
9197. When calling please have your application serial or patent  
number, the type of document you are having an image problem  
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patent business on the Internet. The USPTO's PAIR system  
provides Internet-based access to patent application status and  
history information. It also enables applicants to view the

Art Unit: 1636

scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Any inquiry concerning rejections or objections in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (571) 272-0775. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached at (571) 272-0781.



Terry A. McKelvey, Ph.D.  
Primary Examiner  
Art Unit 1636

September 24, 2004